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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/009,962      | 01/23/2002  | Kikukatsu Ito        | 2001_1838A          | 3213             |

513 7590 08/26/2003

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[REDACTED] EXAMINER

MAYES, LAURIE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1653     | 11           |

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                          |                  |
|------------------------------|--------------------------|------------------|
| <b>Office Action Summary</b> | Application No.          | Applicant(s)     |
|                              | 10/009,962               | ITO, KIKUKATSU   |
|                              | Examiner<br>Laurie Mayes | Art Unit<br>1653 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-6 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 5, 6, drawn to a gene comprising cDNA and a DNA fragment.

Group II, claim(s) 3, 4, drawn to a thermogenic protein.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The DNA and protein of Group I and II have different structures and functions as the DNA encodes a protein while the protein may be used in an assay or to treat diabetes. Further, a DNA fragment comprising a partial sequence of SEQ ID NO: 1 is known in the art (see present claim 5)(WO 96/32483, SEQ ID NO: 130 and see attached copy of sequence alignment).

A telephone call was made to Lee Cheng on August 20, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Mayes whose telephone number is (703) 605-1208. The examiner can normally be reached on Monday through Friday from 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.



Laurie Mayes  
Patent Examiner  
Art Unit 1653



CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800

Software version 5.1.6  
Build 999 - 29/03/2013. Confidential. Ltd.

score greater than or equal to the score of the result being printed, and is derived by analysis of the total score distribution.

| Result No. | Score | Query Match Length | DB ID  | Description           |
|------------|-------|--------------------|--------|-----------------------|
| C 1        | 20.6  | 73.6               | 34     | A57638 Sequence in 13 |
| C 2        | 20    | 71.4               | 10277  | AE009549 Brucella     |
| C 3        | 19.6  | 70.0               | 2322   | AY120689 Arribidops   |
| C 4        | 19.6  | 70.0               | 8      | AY137546 Arribidops   |
| C 5        | 19.6  | 70.0               | 2714   | AF375416 Arribidops   |
| C 6        | 19.6  | 70.0               | 7142   | AF775436 Arribidops   |
| C 7        | 19.6  | 70.0               | 6      | AY385012 Rhabitoides  |
| C 8        | 19.6  | 70.0               | 19768  | AX385018 Rhabitoides  |
| C 9        | 19.6  | 70.0               | 2      | AK096076 Sequence     |
| C 10       | 19.6  | 70.0               | 10916  | Continuation (6 of    |
| C 11       | 19.6  | 70.0               | 8      | AT132977 Arribidops   |
| C 12       | 19.6  | 70.0               | 2      | AC128218 Rattus no    |
| C 13       | 19.6  | 70.0               | 2      | AC127443 Rattus no    |
| C 14       | 19.2  | 68.6               | 2960   | AC11304 Sequence      |
| C 15       | 19.2  | 68.6               | 410    | AX654551 Sequence     |
| C 16       | 19.2  | 68.6               | 68631  | AY121618 Erosophili   |
| C 17       | 19.2  | 68.6               | 2      | AC120551 Erosophili   |
| C 18       | 19.2  | 68.6               | 9      | AC139768 Homo sapi    |
| C 19       | 19.2  | 68.6               | 14404  | AP03219 Homo sapi     |
| C 20       | 19.2  | 68.6               | 12515  | AC139765 Homo sapi    |
| C 21       | 19.2  | 68.6               | 17933  | AC009456 Homo sapi    |
| C 22       | 19.2  | 68.6               | 17028  | AC008315 Homo sapi    |
| C 23       | 19.2  | 68.6               | 243348 | AB036663 Drosophili   |
| C 24       | 19.2  | 68.6               | 251872 | AC111517 Rattus no    |
| C 25       | 19    | 67.9               | 11     | AC125694 Rattus no    |
| C 26       | 19    | 67.9               | 1557   | BV041768 Sequence     |
| C 27       | 19    | 67.9               | 2062   | AB026664 Bankharde    |
| C 28       | 19    | 67.9               | 2225   | X97616 A. thaliana    |
| C 29       | 19    | 67.9               | 10     | AB03683 Mus musculus  |
| C 30       | 19    | 67.9               | 2      | AC1154550             |
| C 31       | 19    | 67.9               | 3      | CE1426072 Genet       |
| C 32       | 19    | 67.9               | 2      | AB066648 Genet        |
| C 33       | 19    | 67.9               | 2      | AB028531 Genet        |
| C 34       | 19    | 67.9               | 9      | AB028531 Genet        |
| C 35       | 19    | 67.9               | 2      | AC123330 Arribidops   |
| C 36       | 19    | 67.9               | 2      | AC096518 Genet        |
| C 37       | 19    | 67.9               | 2      | AC096518 Genet        |
| C 38       | 19    | 67.9               | 2      | AC103262 Rattus no    |
| C 39       | 19    | 67.9               | 2      | AC126653 Rattus no    |
| C 40       | 19    | 67.9               | 2      | AC111221 Rattus no    |
| C 41       | 19    | 67.9               | 2      | AC096524 Rattus no    |
| C 42       | 19    | 67.9               | 2      | AC120693 Rattus no    |
| C 43       | 19    | 67.9               | 2      | AC113717 Rattus no    |
| C 44       | 19    | 67.9               | 2      | AC126644 Rattus no    |
| C 45       | 19    | 67.9               | 1      | AB009446 Rattus no    |
| C 46       | 19    | 67.9               | 1      | AB009446 Rattus no    |
| C 47       | 19    | 67.9               | 1      | AP005229 Genet        |

Fig. 1. Results for number of results recorded for each category.

## ALIGNMENTS

RESULT 7  
 A57638/c  
 LOCUS A57638  
 DEFINITION Sequence 130 from patient W99c2483.  
 ACCESSION A57638  
 VERSION A57638/c  
 VERSION 1  
 linear  
 Fasta  
 MAP-1998

REF ID: A11120  
REFERENCE  
AUTHORS  
TITLE  
JOURNAL  
PATENT  
IMMUNE-EVADING PROTEINS  
MAMUCCI, M. G.  
17-OCT-1995  
130 9634483-B  
19950117  
1  
unclassified.

